

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Katarzyna JURECZEK
Title: SUSTAINED RELEASE TABLET
CONTAINING INDAPAMIDE
Appl. No.: 10/518,386
International Filing Date: 7/24/2002
371(c) Date: 5/3/2005
Patent No.: 7,553,499
Grant Date: 6/30/2009
Examiner: MICAH PAUL YOUNG
Art Unit: 1618
Confirmation Number: 6605

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 6/30/2009 as U.S. Patent No. 7,553,499.

The Patent Office determined that the patent was entitled to 670 days of PTA in the Issue Notification. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B),

and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 1038 days PTA, as shown on the attached sheet (Exhibit B), which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	1093 days
(b) Total Applicant delay:	55 days
Final PTA Determination:	1038 days

Applicants therefore respectfully request that the patent be accorded 1038 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Dated: August 31, 2009

By /Joseph P. Meara/

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UNITED STATES PATENT AND TRADEMARK OFFICE

078556-0155

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,386	06/30/2009	7553499	1034433-000009 (078556-01	6605

23524 7590 06/10/2009

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EXHIBIT A

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 670 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Katarzyna Jureczek, Kraków, POLAND;

DOCKETED

BY

MLB

DATE

6-15-09

SECONDARY DOCKETED

BY

SL

DATE

6/16/09

ACTION (DUE DATE)

BROADENING REISSUE DUE - 6-30-2011

- REQ/RECONSID OF PTA FROM GRANT - 8-30-09 ✓
- DEADLINE FOR PTA CIVIL ACTION - 12-27-09 ✓

*JPM**SL**JEN*

RECEIVED ✓

FOLEY & LARDNER
MADISON, WI
IP DOCKETING

CLOSE WINDOW

ALL CASES SELECT CASE

Patent Term Adjustment Calculation System

EXHIBIT B

Add a new event to this case

Docket Number: 078556-0155
 Application Number: 10/518386
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	07/01/2002	-915		
Edit Delete	International Filing Date	07/24/2002	-892		
	PCT National Stage Commencement Date	01/01/2005	0		
Edit Delete	National Stage Entry (All 371(c) Requirements Met)	05/03/2005	122		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	05/03/2005	122		
Edit Delete	Preliminary Amendment NOT falling under 1.704(c)(6) Received at PTO	05/03/2005	122		
	14 month From Application date	07/03/2006	548		
	3 Year Period Starts	01/01/2008	1,095		
Edit Delete	Non-Final Office Action	06/27/2008	1,273	(725)	
	Non-Final Office Action + 3 months	09/27/2008	1,365		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	11/21/2008	1,420		55
Edit Delete	Notice of Allowance	02/23/2009	1,514		
Edit Delete	Issue Fee Paid	05/21/2009	1,601		
Edit Delete	Patent Grant Date	06/30/2009	1,641	(546) 1093	
	Totals:			1,093	55
	PTA:			1,038	

PTO calls
 725 days
 (55)
 670

547 days
 (non-overlapping event)

55
 546 days of
 non-overlapping event

547
 + 546
 (55)
 1,038

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Version: 3.02.05

LOGIN: Sharon Dudley

IP: 10.24.4.200

Foley & Lardner LLP